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	First Named Inventor	Joseph R. Callol	
	Art Unit	3731	
	Examiner Name	Michael H. Thaler	
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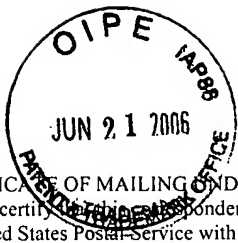
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John S. Nagy, Reg. No. 30,664

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

JOSEPH R. CALLOL ET AL.

Serial No. 10/022996

Filed: December 17, 2001

For: STENT FOR TREATING  
BIFURCATIONS AND METHOD OF  
USE

Examiner: Michael H. Thaler

Group Art Unit 3731

Docket No. ACS 57812

January 30, 2006

Los Angeles, California 90045

REPLY BRIEF

Mail Stop Appeal Brief - PATENTS  
Commissioner for Patents  
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This Reply Brief is responsive to the Examiner's Answer dated April 19, 2006 in connection with the appeal filed in the above referenced matter. This Reply Brief is being filed within the term provided as permitted under 37 C.F.R. § 1.193(b)(1), and is in compliance with 37 C.F.R. § 41.37.

## **ARGUMENTS**

### **I. THE LAM PATENT DOES NOT TEACH OR DISCLOSE "MOUNTING THE STENT ON A CATHETER HAVING A LONG BALLOON AND A SHORT BALLOON WHEREIN THE LONG BALLOON AND SHORT BALLOON ARE POSITIONED SIDE BY SIDE"**

In the Final Office Action dated February 15, 2005, the Examiner rejected claims 8-14 under 35 U.S.C. § 103(a) as being unpatentable over Lam (5,607,444) in view of Kim (6,270,524). The Examiner dismissed Appellant's argument that the Lam patent does not teach or disclose "mounting the stent on a catheter having a long balloon and a short balloon wherein the long balloon and short balloon are positioned side by side."

In the Examiner's Answer dated April 19, 2006, the Examiner stated that the catheter shown in Figure 7 (Lam) has a long balloon on the left side of the figure and a short balloon on the right side of the figure. Referring to appendix A, the Examiner states that the long balloon is to the left side of the figure and the short balloon is to the right side of the figure. The Examiner has stated that the long balloon and the short balloon are positioned "side by side" according to a dictionary definition of "side by side" taken from Dictionary.com. Dictionary.com defines "side by side" as "next to each other; close together." The Examiner states that the Appellant's specification does not include an alternative definition for this term.

**A. THE LONG BALLOON AND SHORT BALLOON IN LAM**  
**ARE NOT POSITIONED "SIDE BY SIDE" AS THE TERM "SIDE BY SIDE" IS**  
**DEFINED IN APPELLANT'S APPLICATION**

Patent application documents may limit and define claim terms without an explicit statement of redefinition. The claim terms may be defined by implication upon a close reading of the specification and review of the drawings. "Even when guidance is not provided in explicit definitional format, the specification may define claim terms by implication such that the meaning may be found in or ascertained by a reading of the patent documents." Phillips v. AWH Corp., 415 F.3d 1303, 1321, 75 U.S.P.Q.2d 1321, 1332 (Fed. Cir. 2005). "A claim term may be clearly redefined without an explicit statement of redefinition." Id.

The Examiner has assigned the claim term "side by side" an overbroad meaning. Dictionary definitions should not be a starting point for determining claim meaning. "The risk of systematic overbreadth is greatly reduced if the court instead focuses at the outset on how the patentee used the claim term in the claims, specification, and prosecution history, rather than starting with a broad definition and whittling it down." Id. at 1321, 75 U.S.P.Q.2d at 1333. "A general-usage dictionary cannot overcome art-specific evidence of the meaning of a claim term." Id. at 1322, 75 U.S.P.Q.2d at 1333. Respectfully, the Examiner has erred in assigning broad dictionary definitions to the claim term "side by side" while ignoring the clear teachings of the specification and drawings of the present application to define the meaning of the claim term. See, MPEP §2111.01.

The specification and drawings of the present application clearly show that the claim term "side by side" is intended to mean that the longer side of the long balloon (117) is positioned next to the longer side of the short balloon (129) during mounting as shown for example, for example, in FIG. 34 of the present patent application. (See Applicant's Exhibit 11.) (Page 48, lines 9-14) Furthermore, the "side by side" positioning in Applicant's FIG. 34 is easily distinguished from the "end to end" positioning in Examiner's Appendix A, Fig. 1. The Applicant's drawings clearly show that the claim term "side by side" should not be given the overly broad meanings of "end-to-end," "by-the-side," or "near-the-side" as argued by the Examiner.

The Examiner has further erred in defining the claim term "side by side" in relation to positioning paintings, boxes, and pencils. The Examiner has taken the claim term "side by side" out of the context of the art and has failed to define the term as it relates to the subject matter of intravascular balloon catheters within the reading of the specification and drawings of the patent application documents. Furthermore, referring to the expanded configuration in Figure 7 of Lam, two objects cannot possibly be considered "side by side" when there is an anatomic vessel wall (41) interposed between them. Even paintings, boxes, and pencils are not considered side by side when there is a wall separating them. The balloons in Lam are not "side by side" because there is not only the vessel wall but also significant anatomic soft tissue interposed between the bent over portions of the balloon when positioned in a bifurcated blood vessel as shown in Lam.

**B.     THE PRIOR ART DOES NOT SHOW THE REQUIRED SIDE  
BY SIDE POSITIONING OF THE BALLOONS DURING THE STEP OF  
MOUNTING OF THE STENT ON THE BALLOONS**

Those skilled in the art would interpret Lam as showing balloon sections positioned "end to end" and not "side by side." With all due respect, the Examiner has improperly altered Figure 1 of the Lam patent in the appendix of the Examiner's Answer and as such Figure 1 and the arguments relating thereto should be ignored on appeal. It is noted that Figure 1 submitted in the appendix of the Examiner's Answer is not the same as Figure 1 in the issued Lam patent. (See Applicant's Exhibit 12.) The Examiner has drawn a line across the balloon that is not present in Figure 1 of the Lam patent as issued. The line has been drawn by the Examiner so that it appears to be joining the radiographic markers (35) and dividing the balloon into two parts. Even with the added matter by the Examiner, the hand drawn balloon sections shown in the appendix of the Examiner's Answer would be interpreted by those skilled in the art to show positioning of the balloon sections "end to end" and not "side by side." At best, Figure 7 of the Lam patent discloses two balloons axially aligned, not side by side. Neither the Lam nor Kim prior art references teach or suggest mounting a stent on a catheter having a long balloon and a short balloon wherein the long balloon and the short balloon are positioned side by side. For this reason alone, claim 8 is patentably distinguishable over Lam and Kim.

**C.     THE LAM REFERENCE DOES NOT DISCLOSE A SHORT  
BALLOON AND A LONG BALLOON**

MPEP §2125 states: When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. See, Hockerson-Halberstadt, Inc. v. Avia Group Int'l, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) (The disclosure gave no indication that the drawings were drawn to scale. “[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.”).

The Lam reference does not disclose that the drawings are to scale and is silent as to dimensions. Furthermore, the Lam reference never explicitly states that one balloon is long and the other balloon is short. Therefore, the Examiner has no valid basis for concluding that Lam reference discloses a long balloon and a short balloon positioned side by side.

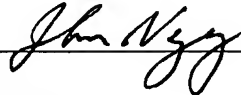
**II.     CONCLUSION**

For the foregoing reasons, it is submitted that the present invention as claimed is not rendered obvious by Lam (5,607,444) in view of Kim (6,270,524), and that the Examiner’s rejections of claims 8-14 were therefore erroneous. The Examiner has not

applied the term "side by side" as defined in the Applicant's patent documents. Appellant respectfully requests reversal of the rejection of claims 8-14.

Respectfully submitted,

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## **EVIDENCE APPENDIX**

### **LIST OF EXHIBITS**

<b><u>EXHIBIT</u></b>	<b><u>DESCRIPTION</u></b>
1	Appealed Claims
2	U.S. Patent No. 5,607,444 to Lam and U.S. Patent No. 6,270,524 to Kim
3	First Office action dated June 28, 2004
4	Amendment filed July 9, 2004
5	Second Office action dated September 24, 2004
6	Amendment filed December 22, 2004
7	Final Office action dated February 15, 2005
8	Amendment filed April 13, 2005
9	Advisory Action dated May 4, 2005
10	Notice of Appeal filed May 13, 2005
11	Figures 27 and 34 from present application as filed
12	Figure 1 from Lam as issued and Figure 1 from Lam as altered by Examiner

(Exhibits 1-10 previously submitted)